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EXAMINER
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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8 *Ex parte* JAY PAUL DRUMMOND, BOB A. CICHON, DAVID WEIS,  
9 JAMES R. CHURCH, MIKAL R. GILGER, JAGADESH MYANA,  
10 TODD BLAKESLEE, ARAVIND DONGARA, MARK A. MOALES, and  
11 RADHIKA BODAPATLA

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Appeal 2007-4204

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Application 09/639,310

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Technology Center 3600

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Decided: April 17, 2008

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22 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and  
23 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

24 FETTING, *Administrative Patent Judge*.

25

DECISION ON APPEAL

26

STATEMENT OF CASE

27 Jay Paul Drummond, Bob A. Cichon, David Weis, James R. Church, Mikal  
28 R. Gilger, Jagadesh Myana, Todd Blakeslee, Aravind Dongara, Mark A. Moales,  
29 and Radhika Bodapatla (Appellants) seek review under 35 U.S.C. § 134 of a non-  
30 final rejection of claims 1-28, the only claims pending in the application on appeal.

31 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

1 We AFFIRM-IN-PART and ENTER NEW GROUNDS PURSUANT TO  
237 C.F.R. § 41.50(b).

3 The Appellants invented an automated banking machine with a document  
4handling portion to send and receive HTML documents and HTTP messages. The  
5document handling portion, along with a device application portion and device  
6interfacing software portion each reside on the same computer and communicate at  
7different IP ports. The automated banking machine can connect users with the  
8institution where they have their accounts. To operate the banking machine a user  
9provides inputs which correspond to an address, such as a URL address, through an  
10address input device. (Specification 7:8 – 8:22).

11 An understanding of the invention can be derived from a reading of exemplary  
12claim 1, which is reproduced below.

- 13 1. A method of operating an automated transaction machine  
14 comprising:
- 15 a) reading customer identification information from a card with a card  
16 reading device in operative connection with an automated transaction  
17 machine;
- 18 b) accessing at least one customer profile value from at least one data  
19 store, responsive to the customer identification information;
- 20 c) generating at least one web page responsive to the at least one  
21 customer profile value; and
- 22 d) displaying the at least one web page at the machine through  
23 operation of a browser, wherein the at least one web page includes a  
24 plurality of selectable transaction options for performing transactions  
25 with the automated transaction machine.

1 This appeal arises from the Examiner's non-final Rejection, mailed June 21,  
 22005. The Appellants filed an Appeal Brief in support of the appeal on September  
 314, 2005. An Examiner's Answer to the Appeal Brief was mailed on December 6,  
 42005. A Reply Brief was filed on February 3, 2006.

5

#### PRIOR ART

6 The Examiner relies upon the following prior art:

Clausing	US 4,091,448	May 23, 1978
Lawlor	US 5,220,501	Jun. 15, 1993
Akiyama	US 5,539,825	Jul. 23, 1996
Jheeta	US 5,619,558	Apr. 8, 1997
Deaton	US 5,642,485	Jun. 24, 1997
Wagner	US 5,742,845	Apr. 21, 1998
Dasan	US 5,761,662	Jun. 2, 1998
Patterson	US 5,915,246	Jun. 22, 1999
Simmons	US ,5,974 451	Oct. 26, 1999
Martin	US 6,304,860 B1	Oct. 16, 2001

7 We also discuss the following art in this Decision.

8 Gatto US 5,546,523 Aug. 13, 1996

9

#### REJECTIONS

10 Claims 1, 2, 3, 9, 10, 13, 21, and 25-28 stand rejected under 35 U.S.C. § 103(a)  
 11as unpatentable over Wagner, Dasan, Lawlor, and Simmons.

12 Claims 5, 8, 12, 20, and 24 stand rejected under 35 U.S.C. § 103(a) as  
 13unpatentable over Wagner, Dasan, Lawlor, Simmons, Deaton, and Jheeta.

14 Claim 22 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
 15Wagner, Dasan, Lawlor, Simmons, and Jheeta.

1 Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Wagner,  
2Dasan, Lawlor, Simmons, and Akiyama.

3 Claims 6, 7, 11, 17, and 23 stand rejected under 35 U.S.C. § 103(a) as  
4unpatentable over Wagner, Dasan, Lawlor, Simmons, and Patterson.

5 Claims 14, 15, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
6over Wagner, Dasan, Lawlor, Simmons, and Clausing.

7 Claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
8Wagner, Dasan, Lawlor, Simmons, Clausing, and Patterson.

9 Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
10Wagner, Dasan, Lawlor, Simmons, Clausing, and Martin.

## 11 ISSUES

12 The issues pertinent to this appeal are

- 13 • Whether the Appellants have sustained their burden of showing that the  
14 Examiner erred in rejecting claims 1, 2, 3, 9, 10, 13, 21, and 25-28 under  
15 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor, and  
16 Simmons.
- 17 • Whether the Appellants have sustained their burden of showing that the  
18 Examiner erred in rejecting claims 5, 8, 12, 20, and 24 under 35 U.S.C.  
19 § 103(a) as unpatentable over Wagner, Dasan, Lawlor, Simmons, Deaton,  
20 and Jheeta.
- 21 • Whether the Appellants have sustained their burden of showing that the  
22 Examiner erred in rejecting claim 22 under 35 U.S.C. § 103(a) as  
23 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Jheeta.

- 1 • Whether the Appellants have sustained their burden of showing that the  
2 Examiner erred in rejecting claim 4 under 35 U.S.C. § 103(a) as  
3 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Akiyama.
- 4 • Whether the Appellants have sustained their burden of showing that the  
5 Examiner erred in rejecting claims 6, 7, 11, 17, and 23 under 35 U.S.C.  
6 § 103(a) as unpatentable over Wagner, Dasan, Lawlor, Simmons, and  
7 Patterson.
- 8 • Whether the Appellants have sustained their burden of showing that the  
9 Examiner erred in rejecting claims 14, 15, and 18 under 35 U.S.C. § 103(a)  
10 as unpatentable over Wagner, Dasan, Lawlor, Simmons, and Clausning.
- 11 • Whether the Appellants have sustained their burden of showing that the  
12 Examiner erred in rejecting claim 16 under 35 U.S.C. § 103(a) as  
13 unpatentable over Wagner, Dasan, Lawlor, Simmons, Clausning, and  
14 Patterson.
- 15 • Whether the Appellants have sustained their burden of showing that the  
16 Examiner erred in rejecting claim 19 under 35 U.S.C. § 103(a) as  
17 unpatentable over Wagner, Dasan, Lawlor, Simmons, Clausning, and Martin.

18 The pertinent issues turn on whether the art applied describes the use of web  
19 pages in financial transaction machines and how they are used.

1                                   FACTS PERTINENT TO THE ISSUES

2       The following enumerated Findings of Fact (FF) are believed to be supported  
3 by a preponderance of the evidence.

4       *Facts Related to Claim Construction*

5           1. The disclosure contains no lexicographic definition of “web page.”

6           2. The ordinary and customary meaning of “web page” is a hypertext  
7           document accessible by the internet.<sup>1</sup>

8           3. A browser is a program that processes or reads HTML documents  
9           (Specification 4:5-6).

10       *Wagner*

11           4. Wagner is directed to open network transaction systems with the  
12           Internet. Wagner provides a server with the capability of communicating  
13           with a number of I/O devices by extending open network  
14           communication protocols and data message formats to communicate  
15           with non-standard I/O devices either coupled to an open network as a  
16           client or coupled to an open network through a client, such as a PC,  
17           credit card terminal, screen phone, or PDA. The server and the I/O  
18           devices communicate through an Internet protocol such as the Hyper  
19           Text Transport Protocol (HTTP), to exchange data between an  
20           application program and non-standard I/O devices over an open network  
21           (Wagner 5:35 – 47).

22           5. Wagner expands the HTTP protocol to communicate with printers,  
23           magnetic card readers, credit card terminals, smart card readers, check

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12<sup>1</sup> Compact Oxford Dictionary

13 [http://www.askoxford.com/concise\\_oed/webpage](http://www.askoxford.com/concise_oed/webpage).

1 readers, PIN pads, bar-code readers, PDAs, or the like, and includes a  
2 command which instructs a non-standard I/O device to disconnect from  
3 the open network and re-couple to a transaction processing system to  
4 transfer funds from a consumer account to a merchant account. The  
5 system permits the consumer to initiate a transaction and order from a  
6 merchant and then use a more secure link supported by PIN entry  
7 devices or the like to reduce the risk of fraud for the transaction (Wagner  
8 5:48 – 6:27).

9 6. Because the server may communicate through such open networks with  
10 non-standard I/O devices, Wagner's system is available through the  
11 Internet, in myriad locations such as retail establishments or in  
12 consumers' homes. For example, a consumer may utilize the standard  
13 capability of an Internet protocol to communicate with a server that  
14 provides information regarding services or goods for sale over the  
15 Internet and then consummate a sales transaction by using the extended  
16 capability of the Internet protocol. Such a home consumer could provide  
17 transaction data through a smart card reader. A central processing site  
18 may accept product ordering information from a non-standard keypad or  
19 touch screen associated with a screen phone terminal at the remote site  
20 and then communicate with the smart card reader to consummate the  
21 transaction, and would be able to communicate with a PIN pad or the  
22 like to ensure the hardware encryption of PINs and other data before it is  
23 transmitted to the server site (Wagner 6:28-53).

24 7. Wagner uses a PAYMENT command that directs a non-standard I/O  
25 device to communicate with a transaction processor. The PAYMENT  
26 command is used by a merchant terminal to submit a consumer's account



number with a merchant deposit account number, or in a consumer's terminal which receives an account number for a merchant account from a merchant's server with the PAYMENT command. On receipt of this command, the client program suspends its operation and passes the account number to a conventional bank processing program co-resident in memory. The bank processing program executes a commercial transaction using a standard VISA protocol or the like. The consumer may use a magnetic stripe reader and a PIN entry device to improve the security of the data transmission. The transaction center may transmit remittance data over the open network to the merchant so the merchant is apprised of payment and ships the ordered product. Once this consumer initiated transaction is complete, the bank processing program terminates and returns control to the client program which may terminate communication with the open network or retrieve information from another server on the open network for another transaction. In this way, the user may use the open network for non-confidential communication such as collecting product information, pricing, and product availability (Wagner 6:54 – 7:18).

8. Wagner provides an editor which permits a user to define the integrated forms for communicating data between the defined database tables and a client application. A database language identifier is substituted in the Internet protocol statements for the database statements contained in the integrated form. The application inserts the data from the form into the database command statements and provides the re-integrated database command statements to the database application. The Internet protocol statements are downloaded as a file which is interpreted by the client

1 program for the collection and submission of data from non-standard I/O  
2 devices to the database application. The database may be queried by or  
3 retrieve data from the non-standard I/O device. The integrated forms are  
4 comprised of the extended HTML language and standard query language  
5 (SQL) database application statements (Wagner 7:25-64).

6 9. Wagner's system is used with well known data transaction systems  
7 which communicate with a plurality of remote terminals to transfer  
8 information used to complete a transaction or compile a database. Such  
9 systems maintain a database of information such as customer or  
10 consumer data that may include customer identification, customer  
11 account numbers, credit limits and/or account balances from which a  
12 customer may draw. Transaction computers may include special purpose  
13 devices such as automatic teller machines (ATMs), point of sale (POS)  
14 terminals, credit card terminals, and screen phone terminals Data input  
15 terminals may include personal computers (Wagner 1:13-33).

16 10. Wagner Figs. 14-22 describe various exemplary transactions performed  
17 by Wagner's system.

18 11. Wagner describes the use of various input forms including both check  
19 boxes and radio buttons, both of which are used for making selections  
20 (Wagner 13:53-61).

21 12. Wagner describes entering information from I/O devices into the HTML  
22 file that is sent to a server. Then that information is used to retrieve  
23 other data from a database which is also inserted into an HTML file for  
24 return (Wagner 17:48-65). This information may be that from a card  
25 reader that reads a credit card to retrieve customer information from a  
26 customer database (Wagner 18:26-36).

1       13.Wagner describes how its system authorizes or denies the transaction  
2       and, if authorized, a printer at the merchant terminal prints a purchase  
3       agreement which the consumer may execute to complete the transaction  
4       (Wagner 18:26-36).

5       *Dasan*

6       14.Dasan is directed to automatic method and system for retrieving  
7       information based on a user-defined profile (Dasan 2:3-4).

8       15.Dasan's program stores a file containing a user-defined profile in order  
9       to retain a state of the user-profile to emulate a server which retains its  
10      state from session to session (Dasan 2:24-27).

11      16.Dasan uses source identification codes in the user profile to designate  
12      which information sources to use (Dasan 2:36-38).

13      17.Dasan allows the user to edit the user profile (Dasan 2:46-47).

14      *Lawlor*

15      18.Lawlor is directed to distributing financial and other services to remote  
16      locations, and providing banking type financial transaction handling via  
17      remote data terminals located in users' homes, offices or other locations  
18      (Lawlor 1:6-10) with a low cost ATM-like terminal (Lawlor 6:56-57).

19      19.Lawlor describes soft keys that offer programmable selection in an ATM  
20      (Lawlor 9:33-42).

21      20.Lawlor provides its system with a terminal screen which permits  
22      targeted advertising without disclosing the user's name or other  
23      confidential information to the advertiser and permits an immediate  
24      customer response to targeted, displayed advertisements, whose

1 responses are then transmitted online or in batch mode to the  
2 advertisement sponsor (Lawlor 14:20-28).

3 *Simmons*

4 21. Simmons is directed to a network access system which distributes  
5 bulletins to external computers by sending bulletins with information  
6 being relayed by the network access system to one or more external  
7 computers. A bulletin server determines whether a bulletin is to be sent  
8 with received information. If so, the bulletin server then selects an  
9 appropriate bulletin to send with the received information. Bulletins may  
10 be sent with the received information by attaching the bulletins to the  
11 information and sending the bulletins and information together, or by  
12 sending the bulletins and information separately (Simmons 3:42-67).

13 22. Simmons retrieves user demographic parameters to target advertisements  
14 (Simmons 5:31-47). Such demographic information is essentially  
15 marketing information in the context of advertising.

16 *Deaton*

17 23. Deaton is directed to a transaction processing system that uses a  
18 customer's financial account number as a unique customer identification  
19 number. The system operates at an individual store, and maintains at that  
20 store a local customer database of customer records, each identified by  
21 the corresponding customer identification number. The system includes  
22 one or more transaction terminals used to transmit a customer  
23 information request (such as for check or credit card transaction  
24 verification), which includes an automatically read customer's  
25 identification number, from the point-of-sale (POS) to the transaction

processor. The transaction processor processes the customer information request, using the identification number to search the customer database and retrieve the corresponding customer record, if any. Based on the customer information in the customer record, or the lack of a customer record, the transaction processor returns an appropriate response (such as credit verification status) and marketing response information to the transaction terminal (Deaton 4:57 – 5:21).

24. Deaton uses smart cards for financial transactions (Deaton 72:54-55) using smart card readers (Deaton 78:28).

#### *Jheeta*

25. Jheeta is directed to marketing to a customer via an ATM. The ATM dispenses to the customer a receipt containing a transaction record, a promotion, and a telephone number for redeeming the promotion by the customer. When the customer calls the telephone number, a telephonic survey is conducted. Answers to the survey questions are stored in a customer profile in a computer database, and the promotion is sent to the customer (Jheeta 1:44-53).

26. Jheeta describes using a card reader for an ATM (Jheeta 2:27).

27. Jheeta describes promotions for cross-selling products and vendors (Jheeta 3:22-37).

#### *Patterson*

28. Patterson is directed to a financial self service system having terminals such as automated teller machines (ATMs) which permit withdrawal of cash, balance inquiry etc. or home banking terminals by which financial

1 transactions and inquiries can be initiated from a user's home or office  
2 (Patterson 1:4-8).

3 29.Patterson describes an ATM which operates in a predictive manner, in  
4 that when a user enters their card, the machine identifies the user,  
5 predicts the transaction most likely to be requested by that user, and  
6 presents one or more relevant messages in accordance with that user's  
7 habitual transaction request or requests (Patterson 1:20-27).

8 30.Patterson describes the use of data in customer profiles for remembering  
9 information concerning a customer (Patterson 1:42-43).

10 *Clausing*

11 31.Clausing is directed to an automated banking system which includes a  
12 central processor that is timeshared by multiple local transaction  
13 processors, each local transaction processor being timeshared by  
14 multiple transaction input/output stations accessible to card-carrying  
15 customers (Clausing 1:6-12).

16 32.Clausing's central processor sends data that includes a customer's  
17 account descriptions, which determines what transactions a customer  
18 may perform (Clausing 5:45-50).

19 *Martin*

20 33.Martin is directed to automated debt payment through established ATM  
21 networks to allow a consumer to initiate an electronic transfer of funds  
22 from a primary bank transaction account (e.g., checking account, savings  
23 account) to satisfy an outstanding consumer debt or payment obligation  
24 (Martin 5:36-45).

25 *Akiyama*

34. Akiyama is directed to a key control method in an electronic cashless transaction system including an IC card as an electronic cashless transaction medium (Akiyama 4:47-51).

35. Akiyama describes conventional smart card processing as accessing a  
bank center unsettled funds file with a customer account and a customer  
card balance file for each holder of an IC card (Akiyama 2:1-7).

7 *Facts Related To The Level Of Skill In The Art*

36. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of financial transactions and internet communications. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

17     *Facts Related To Secondary Considerations*

37. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

## 20 PRINCIPLES OF LAW

### 21 Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004).

1 Limitations appearing in the specification but not recited in the claim are not  
 2 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.  
 3 Cir. 2003) (claims must be interpreted “in view of the specification” without  
 4 importing limitations from the specification into the claims unnecessarily)

5 Although a patent applicant is entitled to be his or her own lexicographer of  
 6 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,  
 7 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such  
 8 definitions in the Specification with sufficient clarity to provide a person of  
 9 ordinary skill in the art with clear and precise notice of the meaning that is to be  
 10 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although  
 11 an inventor is free to define the specific terms used to describe the invention, this  
 12 must be done with reasonable clarity, deliberateness, and precision; where an  
 13 inventor chooses to give terms uncommon meanings, the inventor must set out any  
 14 uncommon definition in some manner within the patent disclosure so as to give  
 15 one of ordinary skill in the art notice of the change).

#### 16 *Obviousness*

17 A claimed invention is unpatentable if the differences between it and the  
 18 prior art are “such that the subject matter as a whole would have been obvious at  
 19 the time the invention was made to a person having ordinary skill in the art.”  
 20 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007);  
 21 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

22 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
 23 several basic factual inquiries: “[ (1) ] the scope and content of the prior art are to be  
 24 determined; [ (2) ] differences between the prior art and the claims at issue are to be  
 25 ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved.” 383  
 26 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The



1 combination of familiar elements according to known methods is likely to be  
2 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

3 “When a work is available in one field of endeavor, design incentives and  
4 other market forces can prompt variations of it, either in the same field or a  
5 different one. If a person of ordinary skill can implement a predictable variation,  
6 § 103 likely bars its patentability.” *Id.* at 1740.

7 “For the same reason, if a technique has been used to improve one device,  
8 and a person of ordinary skill in the art would recognize that it would improve  
9 similar devices in the same way, using the technique is obvious unless its actual  
10 application is beyond his or her skill.” *Id.*

11 “Under the correct analysis, any need or problem known in the field of  
12 endeavor at the time of invention and addressed by the patent can provide a reason  
13 for combining the elements in the manner claimed.” *Id.* at 1742.

#### 14 *Automation of a Known Process*

15 It is generally obvious to automate a known manual procedure or mechanical  
16 device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price*  
17 *Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have  
18 found it obvious to combine an old electromechanical device with electronic  
19 circuitry “to update it using modern electronic components in order to gain the  
20 commonly understood benefits of such adaptation, such as decreased size,  
21 increased reliability, simplified operation, and reduced cost. . . . The combination  
22 is thus the adaptation of an old idea or invention . . . using newer technology that is  
23 commonly available and understood in the art.” *Id.* at 1163.

#### 24 *Obviousness and Nonfunctional Descriptive Material*

25 Nonfunctional descriptive material cannot render nonobvious an invention that  
26 would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir.

12004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

4 ANALYSIS

5 *Claims 1, 2, 3, 9, 10, 13, 21, and 25-28 rejected under 35 U.S.C. § 103(a) as*  
6 *unpatentable over Wagner, Dasan, Lawlor, and Simmons.*

7 *Claim 1*

8 The Examiner found that Wagner described the ATM with a card reader,  
9 generating and displaying a web page, and plural selectable transaction options.  
10 The Examiner further found that Dasan described using a customer profile. The  
11 Examiner implicitly found that one of ordinary skill knew the benefits of providing  
12 functionality unique to each user and concluded that it would have been obvious to  
13 apply Dasan's customer profile to Wagner's device for that reason (Answer 4-6).

14 The Appellants contend that Wagner fails to describe customer identification,  
15 customer profile values, a browser, a web page, a relationship between a web page  
16 and transaction performance, or an ATM (Appeal Br. 19-22). The Appellants then  
17 contend that Dasan, directed to a newspaper, is non-analogous art and also fails to  
18 describe the limitations not found in Wagner. They go on to argue that although  
19 Dasan describes a profile, it is limited to search criteria (Appeal Br. 22-24), that the  
20 remaining two references fail to overcome these deficiencies (Appeal Br. 25) and  
21 that the references do not suggest the desirability of their combination (Appeal Br.  
22 26).

23 We disagree. Wagner describes relying on HTML files for communication  
24 among devices in a financial transaction system, and identifies ATM's as  
25 exemplars of devices in financial transaction systems. Wagner uses HTML files so

1those devices can communicate across the internet in addition to more secure  
2proprietary networks (FF , , & ). Since a web page is simply an HTML file (FF &  
3), Wagner is simply using web pages by another name.

4 While Wagner does not explicitly state that it displays these web pages on a  
5terminal, Wagner does print some of them out, which is simply a hard copy display  
6(FF ). Wagner does explicitly recite using a card reader to read a smart card to  
7access a customer's financial card information for payment processing (FF , , & ).  
8Such payment processing would necessarily and inherently access the customer's  
9profile within the financial database from which payment was secured.

10 And while Wagner does not explicitly state that it offers selectable transaction  
11options, Wagner does both describe multiple transaction types (FF ) and the use of  
12check boxes and radio buttons (FF). Since check boxes and radio buttons must be  
13displayed to be used, and since they are used to provide options in forms, and since  
14Wagner explicitly relies on the use of forms for its communication, Wagner  
15implies that its forms would contain radio buttons and check boxes within some of  
16its forms to provide user selectable options, and suggests those options would  
17include selection among its financial transactions, particularly in light of the  
18known use of such displays of options in ATMs. Since a browser is a program that  
19processes or reads HTML documents (FF ), and Wagner's system processes or  
20reads HTML documents, Wagner's system uses a browser. And since Wagner  
21suggests the display of its documents, Wagner suggests the use of a browser for  
22that display.

23 This leaves the limitation of generating a web page responsive to the customer  
24profile value. The Examiner relies on Dasan, which does indeed generate a web  
25page responsive to a customer profile value (FF ). The Appellants do not dispute  
26this; they only contend that one of ordinary skill would not have looked to Dasan.

1 To the contrary, we find that Dasan is directed to information retrieval in  
2general (FF ), and not uniquely to newspapers as argued by the Appellants. As  
3such, Dasan merely points out that in retrieving information, the contents of what  
4is returned may be predicated upon the contents of a user profile. Since Wagner  
5clearly uses customer profiles in retrieving information, Dasan is simply describing  
6a common technique known to those of ordinary skill employed in such retrieval.

7 But, with the breadth of the limitation in claim 1, Dasan is not even necessary,  
8since Wagner describes embedding the contents of portions of a customer profile  
9in the documents returned, thus generating the returned page responsive to the  
10values so embedded. Claim 1 does not require that the options be responsive, only  
11the web page itself. Finally, we again recognize that Wagner suggests the  
12applicability of its system to ATM's, which inherently display selectable options,  
13as evidenced by Lawlor (FF ), and that different customers having different types  
14of bank or credit accounts will inherently only have certain options available.

15 Thus the combination of Wagner and Dasan describe all of the limitations of  
16claim 1 and the application of Dasan to Wagner is simply that of a technique  
17known to those of ordinary skill.

18 *Claims 9 and 25*

19 Independent claims 9 and 25 are similar to claim 1, and further require  
20accessing data from the customer profile, performing a selected transaction, and an  
21ATM. The Appellants contend that Wagner fails to describe these limitations  
22(Appeal Br. 27-28 and 32-33).

23 We disagree. Wagner describes accessing data from the customer profile (FF ,  
24, & ), performing a selected transaction (FF ), and an ATM (FF ).

25 *Claims 2, 3, and 10*

1 Dependent claims 2 and 10 require an operator modifying a customer profile  
 2value, and using a database. The Appellants contend that Wagner and Dasan fail  
 3to describe these limitations (Appeal Br. 27-28).

4 We disagree. Dasan describes an operator modifying a customer profile value  
 5(FF ), and Wagner describes using a database (FF , , & ).

6 *Claims 26-28*

7 Dependent claims 26-27 combine claims 25 and 9, and claim 28 require a cash  
 8dispenser. The Appellants repeat their arguments as to claims 25 and 9 and  
 9contend that Wagner and Dasan fail to describe the cash dispenser (Appeal Br. 33-  
 1034).

11 We disagree for the reasons we found, *supra*. Wagner's reference to an ATM  
 12(FF ) would inherently include a cash dispenser, so such a dispenser is at least  
 13suggested by Wagner.

14 *Claim 13*

15 Independent claim 13 is similar to claim 1, and further requires a customer type  
 16value in the customer profile that differentiates between classes of customers with  
 17regard to available operations and displays a web page, that is loaded responsive to  
 18the customer type value, in a browser. The Examiner found that Dasan described  
 19these limitations (Answer 5-6). The Appellants contend that Dasan fails to  
 20describe these limitations (Appeal Br. 29).

21 We agree that Dasan fails to describe a customer profile that differentiates  
 22between classes of customers with regard to available operations. The Examiner  
 23appears to be pointing to the source identification codes used by Dasan to store  
 24which information sources the user wants to retrieve information from (FF ).  
 25While a customer type code *per se* can be almost code assigned to a customer,

1 claim 13 describes using the customer type code to differentiate among available  
2 options within a financial transaction machine. This is not done by Dasan's source  
3 identification codes, and the Examiner has not provided any other rationale. We  
4 can find no data elements within the applied references that would suggest this  
5 function as claimed. The Appellants have sustained their burden of showing the  
6 Examiner erred.

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### *Claim 21*

10 Independent claim 21 is similar to claim 1, and further requires retrieving  
11 marketing information for selecting a targeted advertisement that is displayed to  
12 the customer at an ATM. The Examiner found that Lawlor and Simmons  
13 described these limitations and the rationale for them in the benefits of targeted  
14 marketing (Answer 6-7). The Appellants contend that Lawlor and Simmons fail to  
15 make up for the deficiencies of Wagner and Dasan, and that they fail to describe  
16 these limitations in the context of an ATM (Appeal Br. 30-31).

17 We disagree. The Appellants have not contended that Lawlor and Simmons  
18 failed to describe the limitations the Examiner applied them to. Lawlor describes  
19 presenting targeted advertising to an ATM customer (FF & ). Simmons retrieves  
20 user marketing information for such advertising (FF ). We found that Wagner and  
21 Dasan describe and suggest the remaining limitations *supra*, including a context  
22 within an ATM (FF ).

23 The Appellants have not sustained their burden of showing that the Examiner  
24 erred in rejecting claims 1, 2, 3, 9, 10, 21, and 25-28 under 35 U.S.C. § 103(a) as

1unpatentable over Wagner, Dasan, Lawlor, and Simmons but have sustained their  
2burden as to claim 13.

3*Claims 5, 8, 12, 20, and 24 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
4                    *Wagner, Dasan, Lawlor, Simmons, Deaton, and Jheeta.*

5    Claim 5 requires a smart card reader and claims 8, 12, 20, and 24 are directed  
6to software that performs the methods of claims 1, 9, 13, and 21. The Examiner  
7found that Deaton describes a smart card reader, Jheeta describes storing customer  
8identification data in a customer database, and that one of ordinary skill would  
9have applied this to Wagner for ease of identifying a customer (Answer 9) and that  
10Wagner described using software for its steps (Answer 10). The Appellants  
11contend that none of the references describe reading customer identification data  
12from a card reader and repeat the arguments that the art does not describe the steps  
13performed.

14    We disagree. Wagner (FF ), Jheeta (FF ) and Deaton (FF ) describe reading  
15customer identification data from a card reader as in claim 5. Further, since  
16Wagner describes an automated system, it implies the software to implement its  
17methods as applied to claims 1, 9, and 21, which we found *supra*. Because the art  
18applied did not suggest the customer type value of claim 13, it does not imply the  
19claim 20 software to implement the method of claim 13.

20    The Appellants have not sustained their burden of showing that the Examiner  
21erred in rejecting claims 5, 8, 12, and 24 under 35 U.S.C. § 103(a) as unpatentable  
22over Wagner, Dasan, Lawlor, Simmons, Deaton, and Jheeta, but have sustained  
23their burden as to claim 20.

24*Claim 22 rejected under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan,*  
25                    *Lawlor, Simmons, and Jheeta.*

1 Claim 22 further requires including a promotion for the financial institution if  
2 the operator is not a customer. The Examiner found that Jheeta described this  
3 limitation. The Appellants contend that Jheeta's promotion is telephonic and not  
4 part of a display (Appeal Br. 37-38).

5 We disagree that this argument is sufficient to show unpatentability. Simmons  
6 describes displayed advertisements (FF & ). Jheeta shows that cross selling is  
7 known (FF ). The Appellant's contention does not persuade us of error on the part  
8 of the Examiner because the Appellant responds to the rejection by attacking the  
9 references separately, even though the rejection is based on the combined  
10 teachings of the references. Nonobviousness cannot be established by attacking  
11 the references individually when the rejection is predicated upon a combination of  
12 prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097, 231 USPQ  
13 375, 380 (Fed. Cir. 1986).

14 The Appellants have not sustained their burden of showing that the Examiner  
15 erred in rejecting claim 22 under 35 U.S.C. § 103(a) as unpatentable over Wagner,  
16 Dasan, Lawlor, Simmons, and Jheeta.

17 *Claim 4 rejected under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan,*  
18 *Lawlor, Simmons, and Akiyama.*

19 Claim 4 requires that a data store be a smart card. The Examiner found that  
20 Akiyama describes a smart card. The Appellants contend that Akiyama fails to  
21 suggest modifying the remaining art accordingly (Appeal Br. 38-39). We disagree.  
22 Both Wagner (FF ) and Akiyama (FF ) describe reading customer identification  
23 data from a smart card within a financial transaction as in claim 4.



1 The Appellants have not sustained their burden of showing that the Examiner  
 2erred in rejecting claim 4 under 35 U.S.C. § 103(a) as unpatentable over Wagner,  
 3Dasan, Lawlor, Simmons, and Akiyama.

4*Claims 6, 7, 11, 17, and 23 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
 5 *Wagner, Dasan, Lawlor, Simmons, and Patterson.*

6 *Claims 6, 7, and 11*

7 Dependent claims 6, 7, and 11 require using the customer profile value for  
 8selecting a language and a fast cash amount, and modifying the language, fast cash  
 9amount, and last withdrawal amount. The Examiner essentially found that the  
 10ATM's in Wagner performed these functions, except for tracking the last  
 11withdrawal amount. The Examiner took official notice for the pre-existence of  
 12language selection and fast cash functions. The Examiner found that Patterson was  
 13directed to using customer profile values for both operating functions and for  
 14retaining information regarding customer transaction history and preferences  
 15(Answer 13). The Appellants repeat their arguments as to claims 25 and 9 and  
 16contend that Wagner and Dasan fail to describe these limitations (Appeal Br. 39-  
 1741).

18 We disagree. The Appellants do not dispute that ATM's routinely offered a  
 19choice of language, or a fast cash choice prior to the invention. Indeed both  
 20functions were already in use in 1995, a year prior to the earliest claimed filing  
 21date benefit date<sup>2</sup>. The Appellants merely dispute that the applied references  
 22describe using customer profile values for these. We found that Wagner suggested  
 23the application to automated tellers, *supra*. Since these functions were already  
 24well known to be used in ATM's, it would have been obvious to one of ordinary

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50<sup>2</sup> See, for example, the background of existing automated teller technology as  
 51described in Gatto, U.S. Patent Number 5,546,523, filed April 13, 1995.

1 skill to provide these functions in the ATM's suggested by Wagner. Since a  
 2 language and a fast cash amount may be preferences, these would be predictable  
 3 data values for Patterson's customer profiles for predicting selection based on  
 4 preferences (FF & ).

5 Since fast cash transactions as in claim 7 may not be actually selected as  
 6 predicted based on preferences, one of ordinary skill would have known the need  
 7 to provide an override capacity. Further, we find that claim 7 does not even  
 8 require that a fast cash transaction be used *per se*, but only that an amount that is a  
 9 fast cash amount, i.e. that matches a fast cash transaction amount, be used in some  
 10 transaction. Finally, as the Examiner pointed out (Answer 20), the choice of  
 11 profile values are non-functional descriptive material and, although considered, are  
 12 of no patentable weight, *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

13 Because we have supplemented the Examiner's use of official notice of pre-  
 14 existing technology for this rejection with supporting evidence, we designate this  
 15 rejection as a new ground within the meaning of 37 C.F.R. § 41.50(b).

#### 16 *Claim 17*

17 Dependent claim 17 depends from claim 13 and therefore fully incorporates the  
 18 limitations of claim 13. We did not sustain the rejection of claim 13, *supra*.  
 19 Patterson does not overcome the deficiencies of Wagner, Dasan, Lawlor and  
 20 Simmons, and therefore we will not sustain the rejection of claim 17.

#### 21 *Claim 23*

22 Dependent claim 23 combines claims 21 and 2. The Appellants repeat their  
 23 arguments as to claims 21 and 2 and contend that Wagner and Dasan fail to  
 24 describe the cash dispenser (Appeal Br. 33-34). We found these arguments to be

1insufficient to overcome the Appellants' burden, *supra*, and accordingly we find so  
2here.

3 The Appellants have not sustained their burden of showing that the Examiner  
4erred in rejecting claims 6, 7, 11, and 23 under 35 U.S.C. § 103(a) as unpatentable  
5over Wagner, Dasan, Lawlor, Simmons, and Patterson, but have sustained their  
6burden as to claim 17.

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10 *Claims 14, 15, and 18 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
11 *Wagner, Dasan, Lawlor, Simmons, and Clausing.*

12 The Appellants contend that the applied art fails to show a customer type value  
13and asks where the art shows the additional limitations of claims 14, 15, and 18  
14(Appeal Br. 46-47).

15 Claims 14, 15, and 18 depend from claim 13 and therefore fully incorporate the  
16limitations of claim 13. We did not sustain the rejection of claim 13, *supra*.  
17Clausing, however, does overcome the deficiencies of Wagner, Dasan, Lawlor and  
18Simmons. Clausing describes using customer's account descriptions, which  
19determine what transactions a customer may perform (FF ). Claim 13 requires a  
20customer type value that differentiates between classes of customers with regard to  
21operations available with the automated transaction machine. The concatenation of  
22Clausing's customer account descriptions would provide this function. Although  
23Clausing does not explicitly describe these values as differentiating between  
24classes, since a class is simply a collection of members, those customers with the

1 same available transactions would inherently form a class having the attribute of  
2 access to such transactions.

3     So now we must consider the additional limitations of claims 14, 15, and 18.  
4 These require (claim 14) the customer type value corresponds to a servicer of  
5 automated transaction machines and the web page includes a plurality of selectable  
6 servicer options for servicing the automated transaction machine; (claim 15) the  
7 customer type value corresponds to a consumer, the web page includes a plurality  
8 of selectable transaction options for performing transactions with the automated  
9 transaction machine; and (claim 18) the customer type value corresponds to a first  
10 class of customer, the web page includes a first option to perform a first transaction  
11 with the automated transaction machine, wherein when the customer type  
12 corresponds to a second class of customer, the web page does not include the first  
13 option.

14     Since a servicer is simply one who provides service, and operating a piece of  
15 equipment is a form of service, as in the machine is in service, the operation of  
16 Wagner's transaction device with Clausing's customer type values describes the  
17 additional limitations of claims 14. Similarly, since one who operates Wagner's  
18 device may be a consumer, the applied art meets claim 15. Claim 18 simply spells  
19 out the implication of claim 13 and is therefore similarly met by the applied art.

20     The Appellants have not sustained their burden of showing that the Examiner  
21 erred in rejecting claims 14, 15, and 18 under 35 U.S.C. § 103(a) as unpatentable  
22 over Wagner, Dasan, Lawlor, Simmons, and Clausing.

23     Since we relied upon Clausing to make up for the deficiencies in Wagner, we  
24 designate this rejection as a new ground within the meaning of  
25 37 C.F.R. § 41.50(b).

1 *Claim 16 rejected under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan,*  
2 *Lawlor, Simmons, Clausing, and Patterson.*

3 The Appellants contend that the applied art fails to show dispensing an amount  
4 of cash based on the input and that the Examiner's analysis is not even related to  
5 claim 16 (Appeal Br. 48-49).

6 Dependent claim 16 depends from claim 13 and therefore fully incorporates the  
7 limitations of claim 13. We did not sustain the rejection of claim 13, *supra*.  
8 Clausing, however, does overcome the deficiencies of Wagner, Dasan, Lawlor and  
9 Simmons, as we found, *supra*. Thus, we must consider the limitations added by  
10 claim 16. Claim 16 requires that the customer enter an amount to be withdrawn  
11 and dispensing that amount. We agree that the Examiner did not make findings as  
12 to these features, although the Examiner's reliance on Patterson, which describes  
13 the use of profiles in ATM's for customer preferences (FF , , & ) would imply the  
14 Examiner meant to, but made a typographic error in copying text. We agree that  
15 Patterson does suggest these additional limitations, and we further find that these  
16 are normal operations of ATM, as suggested by Wagner (FF ).

17 The Appellants have not sustained their burden of showing that the Examiner  
18 erred in rejecting claim 16 under 35 U.S.C. § 103(a) as unpatentable over Wagner,  
19 Dasan, Lawlor, Simmons, Clausing, and Patterson.

20 Since we relied upon Clausing to make up for the deficiencies in Wagner, and  
21 we provided findings in the absence of findings by the Examiner, we designate this  
22 rejection as a new ground within the meaning of 37 C.F.R. § 41.50(b).

23 *Claim 19 rejected under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan,*  
24 *Lawlor, Simmons, Clausing, and Martin.*

1 The Appellants contend that the applied art fails to show the limitations of  
2 claim 18 from which claim 19 depends (Appeal Br. 49-50).

3 Dependent claim 19 depends from claim 13 and therefore fully incorporates the  
4 limitations of claim 13. We did not sustain the rejection of claim 13, *supra*.  
5 Clausing, however, does overcome the deficiencies of Wagner, Dasan, Lawlor and  
6 Simmons, as we found, *supra*. Thus, we must consider the limitations added by  
7 claim 19. Claim 19 requires that a bill payment transaction. Martin describes this  
8 limitation with an ATM (FF ). We found that the remaining art described and  
9 suggested parent claim 18, *supra*.

10 The Appellants have not sustained their burden of showing that the Examiner  
11 erred in rejecting claim 19 under 35 U.S.C. § 103(a) as unpatentable over Wagner,  
12 Dasan, Lawlor, Simmons, Clausing, and Martin.

13 Since we relied upon Clausing to make up for the deficiencies in Wagner, we  
14 designate this rejection as a new ground within the meaning of  
15 37 C.F.R. § 41.50(b).

## 16 CONCLUSIONS OF LAW

17 The Appellants have not sustained their burden of showing that the Examiner  
18 erred in rejecting claims 1-12, 14-16, 18-19, and 21-28 but have sustained their  
19 burden of showing that the Examiner erred in rejecting claims 13, 17, and 20 under  
20 35 U.S.C. § 103(a) as unpatentable over the prior art.

## 21 NEW GROUND OF REJECTION

22 The following new ground of rejection is entered pursuant to  
23 37 C.F.R. § 41.50(b). Claims 13 and 20 are rejected under 35 U.S.C. § 103(a) as  
24 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Clausing. We found

1that Wagner, Dasan, Lawlor, and Simmons described or suggested all of the  
2limitations in claim 13 except for using the customer type code to differentiate  
3among available options within a financial transaction machine. We found that  
4Clausing described this limitation. *supra*. Thus it would have been obvious to a  
5person of ordinary skill in the art to have applied Clausing's equivalent to a  
6customer type code to differentiate among available options within a financial  
7transaction machine to the remaining art for the additional security provided by  
8restricting available functions. We leave the issue of whether claim 17 is  
9patentable under this combination of references with any of the remaining art of  
10record for the Examiner to consider.

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DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 2, 3, 9, 10, 21, and 25-28 under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor, and Simmons is sustained.
- The rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor, and Simmons is not sustained.
- The rejection of claims 5, 8, 12, and 24 under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor, Simmons, Deaton, and Jheeta is sustained.
- The rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor, Simmons, Deaton, and Jheeta is not sustained.
- The rejection of claim 22 under 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor, Simmons, and Jheeta is sustained.

- 1 • The rejection of claim 4 under 35 U.S.C. § 103(a) as unpatentable over  
2 Wagner, Dasan, Lawlor, Simmons, and Akiyama is sustained.
- 3 • The rejection of claims 6, 7, 11, and 23 under 35 U.S.C. § 103(a) as  
4 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Patterson is  
5 sustained.
- 6 • The rejection of claim 17 under 35 U.S.C. § 103(a) as unpatentable over  
7 Wagner, Dasan, Lawlor, Simmons, and Patterson is not sustained.
- 8 • The rejection of claims 14, 15, and 18 under 35 U.S.C. § 103(a) as  
9 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Clausing is  
10 sustained.
- 11 • The rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over  
12 Wagner, Dasan, Lawlor, Simmons, Clausing, and Patterson is sustained.
- 13 • The rejection of claim 19 under 35 U.S.C. § 103(a) as unpatentable over  
14 Wagner, Dasan, Lawlor, Simmons, Clausing, and Martin is sustained.
- 15 • We enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).
  - 16 ○ Claims 13 and 20 are rejected under 35 U.S.C. § 103(a) as  
17 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Clausing.
  - 18 ○ The rejections of claims 6, 7, 11, and 23 under 35 U.S.C. § 103(a) as  
19 unpatentable over Wagner, Dasan, Lawlor, Simmons, and Patterson;  
20 claims 14, 15, and 18 under 35 U.S.C. § 103(a) as unpatentable over  
21 Wagner, Dasan, Lawlor, Simmons, and Clausing; claim 16 under  
22 35 U.S.C. § 103(a) as unpatentable over Wagner, Dasan, Lawlor,  
23 Simmons, Clausing, and Patterson; and claim 19 under 35 U.S.C.



1           § 103(a) as unpatentable over Wagner, Dasan, Lawlor, Simmons,  
2           Clausing, and Martin are designated as new grounds of rejection.

3           Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides  
4 "[a]ppellant may file a single request for rehearing within two months from the  
5 date of the original decision of the Board."

6           In addition to affirming the examiner's rejection(s) of one or more claims,  
7 this decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b).  
8 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this  
9 paragraph shall not be considered final for judicial review." This Decision  
10 contains a new rejection within the meaning of 37 C.F.R. § 41.50(b) (2007).

11          37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS  
12 FROM THE DATE OF THE DECISION, must exercise one of the following two  
13 options with respect to the new rejection:

14          (1) Reopen prosecution. Submit an appropriate amendment of  
15               the claims so rejected or new evidence relating to the claims  
16               so rejected, or both, and have the matter reconsidered by the  
17               Examiner, in which event the proceeding will be remanded to the  
18               Examiner. . . .

19          (2) Request rehearing. Request that the proceeding be reheard  
20               under § 41.52 by the Board upon the same record. . . .

21          Should the Appellants elect to prosecute further before the examiner pursuant  
22 to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35  
23 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of  
24 the affirmance is deferred until conclusion of the prosecution before the examiner

1unless, as a mere incident to the limited prosecution, the affirmed rejection is  
2overcome.

3        If the appellant elects prosecution before the examiner and this does not  
4result in allowance of the application, abandonment or a second appeal, this case  
5should be returned to the Board of Patent Appeals and Interferences for final action  
6on the affirmed rejection, including any timely request for rehearing thereof.

7        No time period for taking any subsequent action in connection with this appeal  
8may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv)  
9(2007).

10

AFFIRMED-IN-PART

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41.50(b)

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13JRG

14

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